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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/934,310	08/21/2001	G. David Jang	S63.2-10078	8078
490	7590	03/10/2005	EXAMINER	
VIDAS, ARRETT & STEINKRAUS, P.A. 6109 BLUE CIRCLE DRIVE SUITE 2000 MINNETONKA, MN 55343-9185			PREBILIC, PAUL B	
			ART UNIT	PAPER NUMBER
			3738	

DATE MAILED: 03/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/934,310	Applicant(s) JANG, G. DAVID ED	
	Examiner Paul B. Prebilio	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on the Appeal Brief filed December 8, 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34,35,37,42-45 and 47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34,35,37,42-45 and 47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Result of Appeal

An appeal conference was held on this application on March 3, 2005. The conferees were persuaded by Appellant's/Applicant's arguments that the rejections of record were untenable. Although the rejections of non-final Office action of May 2004 were found untenable, the conferees thought that at least some of the claims were not patentable based upon Lindenberg et al because the end flexibilities do not have to be different from each other only from the rest of the stent. For this reason, a non-final Office action is hereby provided in order to set forth new rejections.

Claim Objections

Claims 34, 35, 37 and 42-45 are objected to because of the following informalities:

With regard to claims 34, 35, 37, and 42-45, the language of the claim is unclear because it states that the stent has a tapered configuration in the expanded state. Since only "each annual element" can have an expanded state, the expanded state of the stent lacks antecedent basis.

Appropriate correction is required.

Claim Rejections Based Upon Prior Art

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 34, 35, 42, 43, 44, and 47 are rejected under 35 U.S.C. 102(e) as being anticipated by Brown et al (US 6,348,065), or alternatively, under 35 U.S.C. 103(a) as being unpatentable over Brown et al (US 6,348,065) alone. Brown anticipates the claim language where Brown discloses a stent made from a single piece of material (see column 3, lines 13-17) having ends with different flexibilities than the middle portions (Figure 4 and column 3, line 47 to column 4, line 3). The tapered configuration as claimed along any pair of struts tapering from the point or meeting junction of the pair to the wide or top part of the "V"; see Figure 3 for the stent expanded state which is analogous to the expanded state of Figure 4. The first and second ends of Brown's stent have different flexibilities as compared to the intermediate segments; see column 3, lines 46-53.

As to the limitation requiring that the stent be cut from a tube, it is the Examiner posits that Brown discloses the same structure even though Brown uses a different method of making the same device. In particular, Brown cuts a flat piece of material and then forms the cut material into a tube with welds; see column 2, lines 56-64. This process would result in the same structure as stent cut from a tube as claimed.

Alternatively, the resulting structure of Brown would be substantially identical to that claimed such that it would be clearly obvious in view thereof; see MPEP 2113, which is incorporated herein by reference thereto.

Regarding claim 47, no two annular elements are exactly alike due to machine tolerances that inherently result in at least slight differences. For this reason, even the end annular elements would inherently have slightly different flexibilities as compared to each other. For this reason, the claim language is fully met.

Claims 34, 35, 42, 43, 44, and 47 are rejected under 35 U.S.C. 102(e) as being anticipated by Lindenberg et al (US 5,716,393), or alternatively, under 35 U.S.C. 103(a) as being unpatentable over Lindenberg et al (US 5,716,393) alone. Lindenberg discloses a stent made from a single flat piece of material (see column 3, lines 34-51) having ends with different flexibilities than the middle portions (Figures 2 and 3 as well as and column 3, line 26 to column 4, line 30). The tapered configuration as claimed is at both ends; see Figure 2.

As to the limitation requiring that the stent be cut from a tube, it is the Examiner posits that Lindenberg discloses the same structure even though Lindenberg uses a different method of making the same device. In particular, Lindenberg cuts a flat piece of material and then forms the cut material into a tube with welds; see column 3, lines 34-51. This process would result in the same structure as stent cut from a tube as claimed. Alternatively, the resulting structure of Lindenberg would be substantially identical to that claimed such that it would be clearly obvious in view thereof; see MPEP 2113, which is incorporated herein by reference thereto.

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Regarding claim 47, no two annular elements are exactly alike due to machine tolerances that inherently result in at least slight differences. For this reason, even the end annular elements would inherently have slightly different flexibilities as compared to each other. For this reason, the claim language is fully met.

Claims 34, 35, 37, 42-45, and 47 are rejected under 35 U.S.C. 102(e) as being anticipated by Limon et al (US 6,027,526). Limon anticipates the claim language where the plurality of annular elements (see Figures 2-4) have a compressed and expanded state (see column 5, lines 1-12 and column 2, lines 10-15) as claimed. The tapered configuration as claimed is a radial taper of the outer diameter; see Figures 15 to 18, column 3, lines 2-7 and column 2, lines 16-31. The ends with different flexibilities are described in different terms as being "stronger towards one end to resist collapse", which is the different way of saying that the one end is less flexible; see column 3, lines 2-7. Finally, the stent is made from a tube; see column 8, lines 3-9.

With regard to claims 37, 45, and 47, Applicant is directed to see Figure 18.

Response to Arguments

In response to the claim objection traversal, Applicant is reminded that objections are not appealable issues and must be addressed by filing a petition. The Examiner has maintained the objection because the claim language is still considered objectionable and unclear. The Examiner suggests amending the claim language to overcome the objection.

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With regard to the traversals of the prior art rejections, they were persuasive and the relevant rejections have been withdrawn and replaced with new grounds. For this reason, the Applicant's arguments are considered to be moot.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Barone et al (US 5,360,443) is cited because it has a tapered configuration where one end portion has small stents (annular elements as claimed) and the other end has a different stent size stent (annular element as claimed) such that the claim language may be read on by Barone; see Figure 7.

Goicoechea (US 5,609,627) is cited because it has a taper and a stent with a variable flexibility due to the same size wire being used to make different diameter sections; see Figure 1A.

Marcade (US 5,676,696) shows a tapered structure where some variation in flexibility would inherently result; see Figures 6 and 7.

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, McDermott Corrine can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Paul Prebilic", with a stylized, cursive script.

Paul Prebilic
Primary Examiner
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